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| In re Application of | : | |
| LOWE et al. | : | |
| U.S. Application No.: 10/509,782 | : | DECISION ON PETITION |
| PCT No.: PCT/GB03/01499 | : | UNDER 37 CFR 1.47(a) |
| Int. Filing Date: 04 April 2003 | : | |
| Priority Date: 05 April 2002 | : | |
| Attorney Docket No.: GJE-6941 | : | |
| For: METHOD OF DEFECTING AN | : | |
| ANALYTE IN A FLUID | : | |

This decision is in response to applicants' "Petition to File Application Without Signature of Joint Inventor" filed 25 July 2005, which is being treated as a petition under 37 CFR 1.47(a) to accept the application without the signature of joint-inventor, Anthony Peter James.

BACKGROUND

On 04 April 2003, applicants filed international application PCT/GB03/01499 which claimed a priority date of 05 April 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 23 October 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 05 October 2004.

On 29 September 2005, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment; and an unexecuted declaration.

On 22 March 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 25 July 2005, applicants filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application

or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (4) have been satisfied.

Regarding item (2) above, petitioner states that Anthony Peter James has refused to sign the application. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that petitioner has not shown that a bona fide attempt was made to present the application papers (specification, claims, and drawings) to Anthony Peter James. Petitioner has provided a copy of the communication between Anthony Peter James and Robert Perry, however, the communication fails to identify whether a complete application was attached to the electronic mail communication. Additionally, petitioner has not presented evidence that a complete copy of the application (specification, claims, and drawings) has been mailed to the nonsigning inventor last known address. Lastly, the statement regarding the mailing of the electronic mail communication constitutes secondhand knowledge, in that, the mailing to which the petitioner is averring to was conducted by Robert Perry.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, and drawings) were sent to Anthony Peter James, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Regarding item (3) above, petitioner has not provided a clear statement of the last known address of the non-signing inventor. See M.P.E.P. 409.03(e).

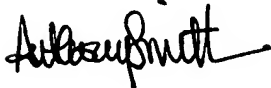
For the reasons stated above, it would not be appropriate to accept the application without the signature of Anthony Peter James under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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